

REMARKS

Applicants amended claims 14 to 20, 22, 24, 27 to 32, and 34. The undersigned discussed the amendments to claims 14 and 24 with Examiner Moore on September 30, 2004. Before entry of the amendments above to claims 14 and 24, those claims included two sequence options separated by the word "or". In a voicemail message left for the undersigned on September 24, 2004, Examiner Moore initially proposed an amendment for each of those options. First, Examiner Moore proposed for the first sequence option of claims 14 and 24 to replace the language "a naturally occurring secretory leukocyte protease inhibitor" with the language "the secretory leukocyte protease inhibitor set forth in SEQ ID NO:1," which the Examiner apparently believed was a species of the second sequence option in those claims.

On September 30, 2004, the undersigned proposed canceling the first sequence option from claims 14 and 24, and relying on the second sequence option of the claims to encompass a particular species, as well as other species. In addition, the undersigned proposed adding new dependent claims 36 and 37, which are directed to a particular species that is disclosed in U.S. Patent No. 4,760,130 at column 6, lines 41 to 48. That patent is incorporated by reference in the present specification at page 3, lines 1 to 2. Examiner Moore agreed that those amendments were acceptable.

Second, in the voicemail message on September 24, 2004, Examiner Moore proposed amending a specific element of the second sequence option of claims 14 and 24. Specifically, the second amendment more clearly defines R1 and R7 as being the same or different and being an amino acid residue. Claims 14 and 24 have been amended to include that language as proposed by Examiner Moore.

Dependent claims 15 to 20, 22, 27 to 32, and 34 have been amended to include language that more closely tracks amended independent claims 14 and 24. None of the amendments add new matter or present new issues. Thus, entry of all of the amendments is respectfully requested. Claims 23 and 35 have been canceled without prejudice or disclaimer. Those claims were canceled because they contain language that was deleted from the claims from which they depend. Claims 14 to 22, 24 to 34, 36, and 37 are pending after entry of the amendments.

The Examiner requested that applicants provide the status of U.S. Application No. 08/209,040. Action at page 2. Applicants have amended page 1 of the specification to include the status of U.S. Application No. 08/209,040.

The Examiner rejected claims 14, 17 to 20, 23, 24, 29 to 23 [sic], and 35 under the judicially-created doctrine of obvious-type double patenting as allegedly being unpatentable over claim 12 of U.S. Patent No. 6,132,990 (the '990 patent). Action at page 2. The Examiner stated that "[t]his is essentially the rejection of record, restated to correspond to the recitations of the new claims 14, 17 to 20, 23, 24, 29 to 23 [sic], and 35 added by Applicant's Amendment." *Id.* Applicants respectfully traverse this rejection.

On September 22, 2004, the undersigned called Examiner Moore to set up an interview to discuss this rejection. The undersigned indicated that in the interview he wanted to discuss the double patenting rejection over the '990 patent and planned to reiterate the arguments presented in the Amendment filed March 15, 2004. On September 24, 2004, Examiner Moore left a voicemail message for the undersigned indicating that the double patenting rejection over the '990 patent would be withdrawn.

Thus, applicants respectfully request reconsideration and withdrawal of the double patenting rejection over claim 12 of the '990 patent.

The Examiner rejected claims 14 to 35 under the judicially-created doctrine of obvious-type double patenting as allegedly being unpatentable over claims 13 to 15 and 17 to 25 of U.S. Patent No. 6,017,880 (the '880 patent). Action at page 4. Solely to expedite prosecution, terminal disclaimers from the two joint assignees and the fees for two terminal disclaimers (\$220.00) are submitted herewith. Accordingly, this rejection is moot.

In view of Examiner Moore's voicemail message left for the undersigned on September 24, 2004, and the discussion with Examiner Moore on September 30, 2004, it is understood that the application would be allowed if the amendments set forth above were presented and the terminal disclaimers in view of the '880 patent were submitted. Applicants respectfully request prompt allowance of the application.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: September 30, 2004

By: 

M. Paul Barker
Reg. No. 32,013